

REMARKS

INTRODUCTION:

As set forth in the preceding section, no claims have been added, amended or cancelled herein.

Claims 1-6 and 8 are pending in the present application. Claims 1, 3, 5, 6 and 8 are independent claims. Reconsideration of the claims in view of the present amendments and the following remarks is respectfully requested.

Applicant also respectfully notes that a Petition for Withdrawal of Finality of the current Office Action was filed on July 7, 2008. The Petition is incorporated herein by reference and a response to the Petition is respectfully requested.

REJECTIONS UNDER 35 USC §102 and §103:

Claims 1-6 and 8 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application No. 2004/0001704 by Chan et al. ("Chan") in view of the Abstract of Korean Patent Publication No. P1997-0029482 by Jin Yong Bang and a partial translation of the underlying document ("Bang"). All of the rejections are respectfully traversed.

Independent claim 8 recites at least the following:

inputting index information of a still picture other than one currently being played;

Chan and Bang, alone or in combination, fail to suggest or disclose all of the above-recited features of independent claim 8.

The Office Action concludes at page 5, last paragraph, that Chan illustrates and describes all of the above-recited features at FIGS. 4 and 6 and pars. [0032], [0036] and [0037]. Applicant respectfully disagrees with the Office Action conclusion for at least the following reasons.

FIG. 4 of Chan merely illustrates a remote control device having left and right and up and down buttons and therefore, absent some other suggestion, FIG. 4 fails to describe all of the above-recited features.

FIG. 6 of Chan merely illustrates an information screen displaying a listing of video files 6-1 - 6-3 located on an optical disc, audio files 7-1 - 7-3 located on the optical disc, and video

files 6-4 and 6-5 on some other inserted media (Aux. Reader Information) (see Chan, par. [0036]). Accordingly, absent some other suggestion, FIG. 6 fails to describe all of the above-recited features.

In addition, Chan describes a number of different playback modes that may be selected by a user allowing playback of still video images with music files. The play back modes are accomplished using a processor chip 100, which "may create in real time an association between still images and audio tracks. The playback modes include: **1)** a first mode, which may present the contents of video files 6 - 1 to 6 -N one by one (and each for a predetermined period of time, e.g., 30 seconds) in order beginning with the first or a selected video file 6, and during this time, each audio file 7 - 1 to 7 -N may be played one by one in order beginning with the first or a selected audio file 7; **2)** a second mode, in which a user 1 may select one and only one audio file 7 to be played while the video files 6 - 1 to 6 -N are presented in order starting from the first or a selected video file 6 - 1; **3)** a third mode, in which a user 1 may select a playlist of audio files 7 - 1 to 7 -N to be played while the video files 6 - 1 to 6 -N are presented in order starting from the first or a selected video file 6 - 1; **4)** a fourth mode, which may present a playlist of video files 6 - 1 to 6 -N in order while a playlist of audio files 7 - 1 to 7 -N are played in order; **5)** a fifth mode, which may present all the video files in a random order starting from a randomly selected file or a file selected by the user 1 , while the processor chip 100 may automatically select one or more audio files 7 for playback; and **6)** a sixth mode, in which a user 1 may specify a one-to-one correspondence between video and audio files using a simple menu interface (e.g., a keypad 410 of a remote control device 15) (see Chan, par. [0037]).

However, none of the modes above from Chan describe inputting index information of a still picture other than a still picture currently being played as recited in claim 8. In fact, Chan would have no reason to describe such a feature because each of the modes of Chan is directed to a single playback mode including various user-selected combinations of images and music files, chosen from images and music files stored in memory.

Independent claim 8 further recites at least the following:

reproducing the still picture and the corresponding audio stream in place of the one currently being played, if the input index is less than the maximum number of still pictures in the first track.

Chan and Bang, alone or in combination, fail to suggest or disclose all of the above-recited features of amended independent claim 8.

The Office Action asserts at page 6 that Chan describes the following at par. [0037]:

“while playing a slide show a user may choose to play a different still image file and corresponding audio stream using remote control and menu of fig 6 using remote control of fig. 4.”

Applicant respectfully disagrees with the preceding Office Action statement because none of the modes set forth in par. [0037] of Chan describe that “while playing a slide show a user may choose to play a different still image file and corresponding audio stream.” In fact, and as set forth in more detail directly above, Chan would have no reason to describe such a feature because each of the modes of Chan is directed to a single playback mode including various user-selected combinations of images and music files stored in memory.

Moreover, Bang fails to compensate for the noted deficiencies of Chan.

Accordingly, Applicant respectfully submits that claim 8 patentably distinguishes over Chan and Bang, and should be allowable for at least the above-mentioned reasons.

Independent claim 5 recites at least the following:

“comparing the input index information with a maximum number of still pictures in a first track of the optical disk;”

Chan and Bang, alone or in combination, fail to suggest or disclose all of the above-recited features of amended independent claim 5.

The Office Action notes at page 6 that Chan fails to describe all of the above-recited features. However, the Office Action proposes to modify Chan with Bang concluding that Bang compensates for the deficiencies of Chan. At page 6, the Office Action states the following regarding Bang:

Bang discloses comparing the input index information (Specific frame sequence data) with a maximum number of still pictures in a first track of the optical disk (Video in a tape) and reading a still picture from the optical disk, corresponding to the input index information if the input index is less than the maximum number of still pictures (when an image is searched all the images will be searched until a desired image is found and when image is found then index must be less than a maximum number of still pictures) in the first track.

Applicant respectfully disagrees with the Office Action analysis for at least the following reasons.

Bang describes a method in “a VCR in which an image desired by a viewer is searched for and then reproduced as a still image in a playback mode.” In the rejection, the Office Action further states on page 7, last sentence, “when an image is searched all the images will be

searched until a desired image is found. Therefore it will also include a maximum number of still pictures.” Applicant disagrees with the rejection because, as the Office Action notes, Bang describes searching all the images **on the entire video tape**. In contrast, the claim 5 recites “comparing the input index information with a maximum number of still pictures in a first track of the optical disk.” Accordingly, Bang fails to describe all of the recited features of claim 5.

Further, Applicant argued in the response mailed April 22, 2008 that “video in a tape,” as described in Bang, cannot be relied upon to disclose a “first track of an optical disk.” In response, the Office Action states on page 7, that the rejection is proper because “it is inherent that the videotape or DVD (optical disk) having tracks [sic]. Applicant again respectfully disagrees with this conclusion because a video tape cannot be used to disclose an optical disk merely because both videotapes and optical disks have tracks. In fact, Bang fails to even mention the term track. Regardless, the term track as used with respect to a videotape is completely different than the DVD audio tracks of the above-recited claims. Accordingly, absent some further suggestion from Bang, Applicant asserts the stated rationale is improper.

Independent claim 5 recites at least the following:

“reading a still picture from the optical disk, corresponding to the input index information if the input index is less than the maximum number of still pictures in the first track;”

Chan and Bang, alone or in combination, fail to suggest or disclose all of the above-recited features of amended independent claim 1.

The Office Action notes at page 6 that Chan fails to describe all of the above-recited features. However, the Office Action proposes to modify Chan with Bang asserting that Bang compensates for the deficiencies of Chan. Applicant respectfully disagrees with this assertion because a video tape cannot be relied upon to disclose an “optical disk,” as asserted in the Office Action.

Moreover, the Office Action asserts that “frame sequence data” of a video tape discloses “index information of a disk.” Applicant again disagrees because the Office Action provides no rationale as to how “frame sequence data” of a video tape may be relied upon to teach index information, as recited in claim 5.

Further, Bang cannot be relied upon to describe “the first track,” as described above in more detail with respect to claim 8.

Accordingly, Applicant respectfully submits that claim 5 patentably distinguishes over Chan and Bang, and should be allowable for at least the above-mentioned reasons. Since

similar features recited by each of the independent claims 1, 3, 6, and 8, with potentially differing scope and breadth, are not suggested or disclosed by Chan and Bang, the rejection should be withdrawn and claims 1, 3, 6 and 8 also allowed.

Further, Applicants respectfully submit that claims 2 and 4, which variously depend from independent claims 1 and 3, should be allowable for at least the same reasons as claims 1 and 3, as well as for the additional features recited therein.

REJECTION BASED ON ABSTRACT IS IMPROPER / EXAMINER NOT RESPONDING

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

In a non-final Office Action mailed March 18, 2008, Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being obvious over Chan in view of the Bang Abstract.

Applicants traversed the Office Action without amending the claims in an Amendment filed on April 22, 2008. In the Amendment, Applicants argued the rejection of the claims based on the Bang Abstract alone is improper. Applicants further requested the Examiner provide a translation of Bang and that the Examiner specifically provide support for the rejection from the underlying specification of Bang rather than the Bang Abstract in a non-Final Office Action, so that Applicants were provided the opportunity to respond to the rejection.

In a Final Office Action mailed June 6, 2008, the claims were again rejected under 35 U.S.C. 103(a) as being obvious over Chan and Bang Abstract. Moreover, only a partial translation of Bang (including claims 1-3) was provided. For example, the partial translation does not include the detailed description of Bang. Further, the Office Action continues to refer to Bang Abstract in support of the rejections, as seen on page 3 of the Final Office Action. There, the rejection appears to be a verbatim repetition of the rejection set forth in the March 18, 2008 Office Action.

As previously argued in the Amendment filed on April 22, 2008, the rejection of the claims based on Bang Abstract without citation of and reliance upon the underlying document is improper (see MPEP § 706.02, part II). In the same Amendment, Applicants requested that a new non-Final Office Action be issued so that Applicants were afforded the opportunity to reply to a rejection based on Bang and not the Bang Abstract before issuance of a final Office Action.

Accordingly, both the non-final Office Action mailed March 18, 2008 and the Final Office Action mailed June 6, 2008 are improper and Applicants respectfully request that a new non-Final Office Action be issued. If any future Office Action continues to rely on Bang in support of the rejection, Applicant respectfully requests a **complete** translation of the entire Bang document. Applicant further requests that any rejections refer to the underlying Bang document rather than to the Bang Abstract.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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